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PILLSBURY WINTHROP SHAW PITTMAN, LLP
P.O. BOX 10500
MCLEAN, VA 22102

EXAMINER

KYLE, MICHAEL J

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3676

DATE MAILED: 05/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/747,651

Applicant(s)

ROLLINS ET AL.

Examiner

Michael J Kyle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. In view of the Appeal Brief filed on January 10, 2005, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.
2. To avoid abandonment of the application, appellant must exercise one of the following two options:
3. (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
4. (2) request reinstatement of the appeal.
5. If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
7. Claims 7 and 21 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 7 and 21 recite a “tracer image”. It is unclear based on the description in the specification and claims, how the tracer image is implemented in the present invention, and specifically what it’s function is. As best understood, the tracer image appears to be some sort of authentication or other security measure, to restrict access to information.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1, 2, 4, 6, 8-10, 12-16, 18, 20, 22-24, and 26-29, are rejected under 35

U.S.C. 102(e) as being anticipated by Markus (U.S. Patent No. 6,499,042).

10. With respect to claims 1, 2, 4, 6, 15, 16, 18, and 20, Markus discloses a method for processing requests from a client (web browser 13) for electronic documents (17) located at a server (document server 15), comprising the steps of receiving, by an intermediary (selective proxy 14) disposed between the client (document browser) and server (document server, see figure 1) a request (column 3, lines 29-31) from the client for an electronic document located at a first address at the server. The request is made by a user (external entity) at the client. The intermediary (14) retrieves the electronic document from the first address (on document server 15, column 3, lines 36-38) and information associated with the user (in task 26). An updated electronic document is generated (by filling in blank fields) from the retrieved electronic document that includes at least a portion of the information associated with the user. The updated electronic document is provided to the client (13) in response to the request (column 3, lines 42-43). Additionally, Markus discloses receiving validation data from the user and validating the validation data (column 3, lines 30-32). The information associated with the user

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is stored via an Internet cookie (Abstract). The electronic document is a web page, and the updated electronic document is a web page generated by an integrated order mechanism.

11. With respect to claims 8-10 and 22-24, Markus discloses the information associated with the user to be retrieved via a post from a server. The examiner considers the contacting of the Selective Proxy to be a post from a server. Markus also discloses the request from the user to be received at an intermediary (14), wherein the electronic document is stored on a server (document server 15), wherein the retrieving the electronic document comprises the steps of sending a new request from the intermediary (14) to the server (15, column 3, lines 36-38), and receiving at the intermediary, the electronic document from the server. Markus also discloses the information associated with a user to be retrieved from a wallet server. The user information in Markus is retrieved from the selective proxy. Because the selective proxy contains personal information, the examiner considers it a wallet server.

12. With respect to claims 12-14 and 26-28, Markus discloses the step of generating the electronic document to comprise generating the updated electronic document by updating one or more data fields based upon information associated with the user. Markus also determines whether one or more variables included in the electronic document include valid user data and revises the electronic document by substituting one or more data values from the user information. Examiner asserts that a blank field is not valid user data. Markus fills blank fields with valid user data. Furthermore, Markus determines whether one or more variables in the electronic document correspond to at least one of a plurality of data values, when one or more variable does not correspond, Markus examines the context in which each of the variables is

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used, identifies a particular data value from the plurality of data values, and substitutes the particular data value (column 3, lines 39-41, "processed in the context...").

13. With respect to claim 29, Markus discloses a method for processing requests from a client (13) for electronic documents located at a server (15) comprising an intermediary (selective proxy 14), and a server that is associated with an electronic document (document server 15) located at a first address at the server, wherein the intermediary (14, column 3, lines 36-38), in response to a request from the client made by a user (external entity) at the client, retrieves the electronic document (17) from the first address and information associated with the user and generates an updated electronic document from the retrieved electronic document (by filling in blank fields) including at least a portion of the information associated with the user.

14. With respect to claims 30 and 31, the intermediary (14) is neither the client (13) nor the server (15).

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 3 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Markus ("Markus '042") in view of Markus et al ("Markus '601", U.S. Patent No. 6,490,601). While Markus '042 suggests that storing information associated with the user may be used with one or more other electronic documents, it is not specifically disclosed.

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17. Markus '601 teaches that stored user information may be used with one or more other electronic documents. This allows the user information to be automatically filled in forms from a plurality of websites that are affiliate members of the service (column 7, line 63 – column 8, line 12). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Markus '042 so that the user information may be used with one or more other electronic documents, so that the user only has to register information at one central location.

18. Claims 5, 11, 19, 25, are rejected under 35 U.S.C. 103(a) as being unpatentable over Markus in view of Godin et al ("Godin", U.S. Patent No. 5,890,138). Markus discloses personal information to be stored in a cookie, and to be retrieved when needed. Because this cookie stores personal information, the examiner considers it a wallet cookie. However, Markus fails to disclose the information to be stored in an encrypted format.

19. Godin teaches an online auctioning system where the user may pre-register personal information, such as an I.D. number, and financial information, and store this information on a database, to allow for automated payment. The information is encrypted on the database. Encrypting this sensitive personal information limits access to the information by an unauthorized party. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to encrypt the stored user information of Markus as taught by Godin, so as to limit, and prevent access to the user's personal information. This information is retrieved in order to pay for an item.

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20. Claims 7 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Markus in view of Rhoads (U.S. Patent No. 6,285,776). Markus fails to disclose the user information to be retrieved via the use of a tracer image.

21. Rhoads teaches the use of a tracer image to identify a specific article can be identified through use of a detecting apparatus. This makes identifying marks difficult for unauthorized persons to recognize without proper equipment. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Markus by including a tracer image to identify a user, and retrieve the associated user information, so as to provide discrete way of identifying the user.

Response to Arguments

22. Applicant's arguments with respect to claims 5, 11, 19, and 25 have been considered but are moot in view of the new ground(s) of rejection. These claims are now rejected by the combination of Markus and Godin.

23. Applicant's arguments filed in the Appeal Brief of January 10, 2005 have been fully considered but they are not persuasive.

24. With respect to claims 1, 15, and 29, applicant argues that Markus '042 fails to show the features argued in the first full paragraph on page 4 of the appeal brief. Examiner respectfully disagrees. Examiner references Markus '042, column 3, lines 29-31, where it states that the Document Browser, or client, contacts the Selective Proxy, or intermediary. This is in response to a request from the external entity (column 3, line 22), or user, making a request (column 3,

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lines 22-24). Because Markus '042 discloses at least the steps that are claimed, Markus is considered to read on these limitations.

25. With respect to claim 13 and 27, applicant argues that filling a blank field is clearly not the same as revising invalid data fields. Applicant has not supported this allegation with any evidence. For this reason, examiner maintains the rejection of claims 13 and 27. Additionally, there are no limitations in the claims that would preclude this interpretation of the claims.

26. With respect to claims 14 and 28, applicant argues that Markus '042 fails to show the step of "examining a context..." and "identifying a particular data value...". Examiner respectfully disagrees, and refers to Markus '042, column 3, lines 39-41.

27. Applicant's argument regarding claims 3 and 17 relies on the allegation that claims 1 and 15 (from which claims 3 and 17 depend) are allowable. Examiner respectfully disagrees. Claims 1 and 15 have been addressed above.

28. In response to applicant's argument (with respect to claims 7 and 21) that Rhoads is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Rhoads is reasonably pertinent to the particular problem with which the applicant is concerned. Applicant argues that Rhoads is not concerned with the particular problem with which the applicant is involved, because these problems are associated with processing orders over the internet including the completion of order forms and the payment commissions to shopping applications and portals. Examiner notes claims 7 and 21 deal with a "tracer image". It is

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unclear how the claimed tracer image pertains to the problems described above. As best understood, the tracer image is some sort of a security or authentication feature. Rhoads uses the tracer image to identify a specific article can be identified through use of a detecting apparatus. This makes identifying marks difficult for unauthorized persons to recognize without proper equipment. Therefore, Rhoads is pertinent to the problem with which applicant is concerned. A valid tracer image will allow data to be retrieved in the combination of Markus '042 and Rhoads. Examiner notes the argument in the last 2 paragraphs of page 9 of the appeal brief, refer to a rejection of Markus '042 in view of Wong. Examiner believes this is a typographical error and should reference the rejection of Markus '042 in view of Rhoads, as the combination of Markus '042 and Wong has not been applied to claims 7 and 21.

Conclusion


29. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J Kyle whose telephone number is 571-272-7057. The examiner can normally be reached on Monday - Friday, 8:30 am - 5:00 pm.

30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Swann can be reached on 571-272-7075. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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31. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mk



Chuck Mah
Primary Examiner
Technology Center 3600